

### REMARKS

Applicant has carefully reviewed the Final Office Action mailed on December 1, 2003. Applicant respectfully traverses all objections, rejections, and assertions made by the Examiner. Claims 1-10 remain pending.

Claims 1-3 are rejected under 35 U.S.C. §102(e) as being anticipated by Ferrera et al. in U.S. Patent No. 6,240,231. The Examiner indicated that Applicant is claiming the process of making a catheter and that this process is not novel. We disagree with both assertions. Turning now to claim 1, two structural elements are claimed:

an inner member defining an outer surface thereon; and  
a first layer disposed over at least a portion of the outer surface of the inner member, the first layer including a selectively curable material, the first layer further comprising first and second portions of the selectively curable material;

Importantly, the second element recites to a layer that includes a selectively curable material. According to page 10, lines 5-6 of Applicant's specification, an example of a selectively curable material is an ultraviolet-curable epoxy. Of course, other selectively curable materials are also contemplated.

Claim 1 goes on to recite a series of elements that modify the first layer. The first element is:

wherein the first portion of the selectively curable material is at least partially cured and the second portion of the selectively curable material is either uncured or cured to a lesser degree than the first portion of the selectively curable material;

This element is structural because the "curing process" (which is not recited in the claim) changes the structure of the selectively curable material as described at page 10, lines 10-16 of the specification:

In an exemplary embodiment, an ultraviolet-curable epoxy is understood to be an epoxy that undergoes a physical change, for example, it becomes cured when exposed to ultraviolet light. According to a preferred embodiment of the current invention, curing is understood to be the process of preparing, preserving, or finishing a substance by a chemical or physical means. Preferably, curing alters the physical properties of a substance. In a preferred embodiment, curing ultraviolet-curable epoxy alters the stiffness of catheter shaft 10.

Not claimed  
plus pages

Claim 1 does not specify method steps or the product of a series of method steps. Instead, claim 1 specifies structurally distinct first and second portions. The first and second portions are structurally distinct based on the structural differences achieved by differential levels of curing. In essence, Applicant is claiming a layer of material that has structurally distinct first and second portions that are differentiated by their respective physical characteristics. In order to clarify this line of reasoning, it may be useful to create an analogy to the organization of claim 1. For example, the claimed structural differences between the first portion and the second portion could be thought of as being analogous to ice and water. Clearly, ice and water are structurally distinct. Using this analogy, Applicant is claiming a device having a first "water" portion and a second "ice" portion. Claim 1 is not attempting to claim the process of freezing the "water" portion in order to create the "ice" portion or the product resulting from the process of freezing the "water" portion.

In addition to these structural elements, claim 1 adds claim elements regarding flexibility:

wherein the first portion of the selectively curable material has a first flexibility and the second portion of the selectively curable material has a second flexibility; and

wherein the first flexibility and second flexibility are different.

Thus, not only are the first and second portion physically different based on the amount of curing each portion has undergone, they also have different flexibilities. In summary, claim 1 is structural in nature and includes a number of structural elements.

Ferrera et al. disclose the use of an ultraviolet-curable adhesive for attaching a strain relief and hub to a catheter shaft. Although Ferrara et al. do disclose an ultraviolet-curable material, they do not appear to disclose that their layer of adhesive has any structurally distinct portions. In particular, Ferrara et al. do not appear to teach or disclose that their adhesive has portions that are cured to differing extents or that different portions of the adhesive have different flexibilities. As stated above, Applicant's claim 1 clearly recites structurally different portions of selectively curable first layer. Ferrara et al. fail to disclose these structurally distinct portions. Because Ferrara et al. fail to disclose a structural limitation of claim 1, Ferrara et al. cannot anticipate claim 1. Based on this distinction, claims 2-3 are also not anticipated, because they depend from claim 1 and because they add significant elements to distinguish them further from the prior art.

Claims 1 and 4-6 are rejected under 35 U.S.C. §102(e) as being anticipated by Derbin et al. in U.S. Patent No. 6,562,021. As described above, claim 1 recites that the first layer has structurally distinguishable first and second portions. In a manner very similar to Ferrera et al., Derbin et al. disclose the use of an ultraviolet-curable adhesive for attaching a strain relief and hub to a catheter shaft. Like Ferrera et al., Derbin et al. do not appear to disclose that the adhesive includes structurally distinct first and second portions. More particularly, Derbin et al. do not appear to disclose that the adhesive includes first and second portions that are structurally differentiated by their level of curing and by their flexibility. Because Derbin et al. fail to disclose a structural element of claim 1, Derbin et al. cannot anticipate claim 1. Based on this distinction, claims 4-6 are also not anticipated because they depend from claim 1 and because they add significant elements to distinguish them further from the prior art.

Claims 1-6 are rejected under 35 U.S.C. §102(b) as being anticipated by Berg et al. in U.S. Patent No. 5,897,537. As described above, claim 1 recites that the first layer has structurally distinguishable first and second portions. Like Ferrera et al. and Derbin et al., Berg et al. only appear to disclose the use of a ultraviolet-curable material. Berg et al. disclose that the ultraviolet-curable material may be part of a layer of filler material. Please see, for example, Berg et al. at column 9, line 66 through column 10, line 4. Berg et al., however, do not appear to disclose that the filler material includes structurally distinct portions. More particularly, Berg et al. do not appear to disclose that the filler material includes first and second portions that are structurally differentiated by their level of curing and by their flexibility. Because Berg et al. fail to disclose a structural element of claim 1, Berg et al. cannot anticipate claim 1. Based on this distinction, claims 2-6 are also not anticipated, because they depend from claim 1 and because they add significant elements to distinguish them further from the prior art.

Claims 7-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ferrera et al. or Derbin et al. in view of Berg et al. In light of the above remarks, Applicant respectfully submits that claim 1 is in condition for allowance based on the failures of all three cited references to disclose the structural limitations of claim 1. Because claims 7-10 depend from claim 1, they are also allowable based on these remarks and because they add significant elements to distinguish them further from the prior art. Accordingly, Applicant respectfully requests that this rejection be withdrawn and that claim 7-10 be allowed in due course.

elements to distinguish them further from the prior art. Accordingly, Applicant respectfully requests that this rejection be withdrawn and that claim 7-10 be allowed in due course.

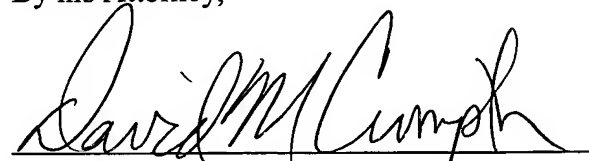
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Henry J. Pepin

By his Attorney,

Date: 1/30/04



David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349